

### **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed October 20, 2006. Through this response, Applicants have amended claims 1, 10-15, 17, 18, 23-25, 29, 30, 32, 35, 40-47, 50-54, 57, 58, 61-63, 66, 74-76, 78, 83, 85-87, 95, 110, 111, 113, 115, 118, 120, and 126, and have canceled claims 21-22, 31, 64-65, and 104-108 without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1, 3-20, 23-30, 32-58, 60-63, 66-103, and 109-128 are respectfully requested.

#### **I. Claim Rejections - 35 U.S.C. § 102(e)**

##### **A. Statement of the Rejection**

Claims 104-109, 110, 119, 121, and 127 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Daniels et al.* ("*Daniels*," U.S. Pat. No. 6,973,669). Applicants have canceled claims 104-108, and hence respectfully submit that the rejection to these claims has been rendered moot. Additionally, Applicants respectfully traverse the rejection to claims 109, 110, 119, 121, and 127 for at least the reasons set forth below.

##### **B. Discussion of the Rejection**

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Daniels* reference. Applicants discuss the *Daniels* reference and Applicants' claims in the following.

## Independent Claims 109 and 121

Claims 109 and 121 recite (with emphasis added):

109. A hyper-linked data caching system comprising:  
a memory; and  
a processor configured with the memory to ***cache hyper-linked data in a data structure indexed by time of presentation within a corresponding media content instance.***

121. A hyper-linked data caching method comprising the steps of:  
receiving hyper-linked data corresponding to a media content instance; and  
***maintaining the hyper-linked data in a data structure indexed by time of presentation within the corresponding media content instance.***

Applicants respectfully submit that *Daniels* fails to anticipate at least the above-emphasized claim features.

The Advisory Action (page 2) alleges:

*Daniels* specifically discloses wherein the pages are downloaded and cached during reception of the program (column 24, lines 11-21) to provide information about the current section of the program (column 23, lines 35-50). The data is indexed by time of presentation, as the data is downloaded according to the current presentation time, as the data is pertinent to a particular section of the presentation (column 23, lines 35-50 and column 24, lines 11-34).

Applicants respectfully disagree.

*Daniels* (col. 4, ln. 32-35 and col. 24, ln. 13-16) describes the receipt and saving of data as:

Once received, this information can be stored on a conventional data storage device, such as a hard drive, RAM, or the like, so that it is retrievable by a viewer at any time.

A number of such hyper linked pages can be downloaded and cached by the inventive multi-featured multi-media appliance 1000 during the reception of the television program. . .

It appears that *Daniels* discloses *arguendo* merely receiving and storing hyperlinked and web page data, and does not disclose, teach, or suggest the feature of caching "hyper-linked data in a data structure indexed by time of presentation within a corresponding

media content instance." In fact, *Daniels* does not disclose any type of indexing data in a data structure. Further, Applicants have not found anything in the *Daniels* reference that suggests that the cached data is "received and stored in order" as alleged in the Office Action. Thus, for at least this reason, Applicants respectfully request that the rejection of claims 109 and 121 be withdrawn.

Additionally, assuming, *arguendo*, that in *Daniels* the data is downloaded "according to the current presentation time, as the data is pertinent to a particular section of the presentation" as alleged in the Office Action, Applicants disagree that this alleged disclosure anticipates Applicants' claimed feature of "maintaining the hyper-linked data in a data structure indexed by time of presentation." Indeed, *Daniels* does not disclose, teach, or suggest any type of indexing for the television programming let alone indexing hyper-linked data in a data structure by time of presentation. Thus, Applicants respectfully submit that the Advisory Action allegation recited above is unsupported by the reference because *Daniels* fails to disclose indexing the television programming by time of presentation. Thus, for at least this additional reason, Applicants respectfully request that the rejection of claims 109 and 121 be withdrawn.

Because independent claims 109 and 121 are allowable over *Daniels*, dependent claims 110, 119, and 127 are allowable as a matter of law for at least the reason that the dependent claims 110, 119, and 127 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Rejection of Claims 1-14, 16-20, 58-63, 69-75 and 77-81**

Claims 1-14, 16-20, 58-63, 69-75, and 77-81 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Payton* ("*Payton*," U.S. Pat. No. 5,790,935) in view of *Norwood et al.* ("*Norwood*," U.S. Pat. No. 5,983,316). Claims 1, 4, 15, 21-36, 38, 48, 49,

58-59, 64-68, 76, 82-92, 94, and 102-103 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniels* in view of *Norwood*. Claims 1, 4, 36, 37, 39-47, 58, 59, 92, 93, and 95-101 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Schein et al.* ("*Schein*," U.S. Pat. 6,002,394) in view of *Norwood*. Claims 111-118, 120, 122-126, and 128 have been rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Daniels* in view of *Shimoji et al.* ("*Shimoji*," U.S. Pat. 6,757,911). Claims 50-57 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniels* and *Norwood* and in further view of *Shimoji*. Applicants respectfully traverse these rejections where not rendered moot by amendment.

#### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

#### **Independent Claims 1 and 58**

Claims 1 and 58 recites (with emphasis added):

1. A dual mode file system in a subscriber network television system, comprising:  
a digital home communication terminal (DHCT) comprising:  
a memory with logic; and

a processor configured with the logic to determine whether a local file system is coupled to the DHCT, the processor further configured with the logic to, responsive to determining that the local file system is not coupled to the DHCT, use remote data from a virtual file system to support the processor; the processor further configured with the logic to, responsive to determining that the local file system is coupled to the DHCT, use local data stored in the local file system and the remote data from the virtual file system to support the processor;

wherein the local file system comprises a storage device with media, ***wherein the media is partitioned into a data portion with a data format for storing data and low memory consumption media content and a media content portion for storing media content, the media content portion having a media content format,***

***wherein the processor is further configured with the logic to receive media content into the data portion unless the received media content consumes a threshold memory capacity that results in the processor receiving the media content with at least the threshold memory capacity into the media content portion.***

58. A dual mode file method in a subscriber network television system comprising the steps of:

determining whether a local file system is coupled to a digital home communication terminal (DHCT);

responsive to determining that the local file system is not coupled to the DHCT, using remote data from a virtual file system to support a processor in the DHCT;

responsive to determining that the local file system is coupled to the DHCT, using local data stored in the local file system and the remote data from the virtual file system to support the processor;

***partitioning the local file system into a data portion and a media content portion; and***

***receiving media content into the data portion, unless the media content consumes a threshold memory capacity that causes it to be received into the media content portion.***

Applicants respectfully submit that the rejections to claims 1 and 58 have been rendered moot. Additionally, Applicants respectfully submit that the art of record fails to disclose, teach, or suggest at least the above-emphasized claim features. Applicants have amended claims 1 and 58 to incorporate features found in previously presented claims 21-22 and 64-65, respectively, and hence address the rejections to those claims in addition to the corresponding base claims.

The Office Action (page 15, emphasis added) alleges the cited references disclose:

... wherein the processor is further configured with the logic to receive the media content into the data portion (see Daniels at column 10, lines 16-30 unless the media content consumes a threshold memory capacity (extending past the time and storage needed for the break; see Daniels at column 10, lines 16-30) that results in the processor receiving the media content with at least the threshold memory capacity into the media content portion (see Daniels at Column 10, lines 30-40)

Applicants respectfully disagree. *Daniels* recites (Col. 10, lines 30-40):

While the viewer is viewing the time shifted portion of the television program, a second recording means 20 records in a second recording medium 22 another selected portion of the time sequential signal. In other words, since the television program continues on time sequentially, while the viewer is viewing the first recorded portion recorded in the first recording medium 16 the second recording means 20 continues recording the time sequential signal at the point at which the recording by the first recording means 14 is stopped so that the signal can be played back.

The cited references simply fail to disclose, teach, or suggest the claimed features of "receiving the media content into the data portion, unless the media content consumes a threshold memory capacity that causes it to be received into the media content portion. receiving the media content into the data portion, unless the media content consumes a threshold memory capacity that causes it to be received into the media content portion."

It appears that *Daniels* merely discloses *arguendo* how a device time shifts a television program. There is simply no disclosure of the above claimed features in *Daniels* or elsewhere in the art of record. Thus, Applicants respectfully request that the rejection to independent claims 1 and 58 be withdrawn.

Because independent claims 1 and 58 are allowable over the cited references, dependent claims 3-20, 23-30, 32-57 and 60-63, 66-103 are allowable as a matter of law.

#### **Dependent Claims 111-118, 120, 122-126, and 128**

Applicants submit that as provided above, independent claims 109 and 121 are allowable over *Daniels*. Applicants respectfully submit that *Shimoji* does not remedy the above-described deficiencies of *Daniels*. Thus, for at least the reasons that dependent claims 111-118, 120, 122-126, and 128 incorporate the features of respective allowable

claims 109 and 121, dependent claims 111-118, 120, 122-126, and 128 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* for obviousness is not made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

### **III. Official Notice**

The Office Action has made the following allegations of Official Notice (location in the Office Action and claim relevance noted in parenthesis):

(Page 21, pertaining to claims 26 and 84) The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant for a television receiver to utilize both an analog and digital transmission channel, such as when receiving both off-air television and digital satellite, for the typical benefit of providing a viewer with an increased amount of information and content by allowing access to both digital and analog content providers and connections.

(Page 36, pertaining to claims 5-8 and 69-72) In response to applicant's traversal of the Official Notices presented for claims 5-8 and 69-72, it is noted that the current rejections provide Norwood as specifically disclosing all of these claimed features.

(Page 36, pertaining to claims 26 and 84) In response to applicant's traversal of the Official Notices presented for claims 26 and 84, applicant is directed to Rasson et al. (6,137,549) and Basawapatna et al. (6,598,231) which disclose that it was well known to receive both analog and digital channels.

Applicants respectfully traverse these allegations of well-known or Official Notice and submit that the subject matter pertaining to these claims should not be considered well-known. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner

where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language, such a finding of well known art is improper at least given the added complexity associated with such features as described in claims 5-8, 26, 84, and 69-72.

Additionally, Applicants respectfully submit that in regards to claims 5-8 and 69-72, none of the cited references disclose that the claimed features as amended for similar reasons as discussed in the response to the rejection of the claims above.

Further, in regards to claims 26 and 84, neither *Rasson* nor *Basawapatna* establish that it was well known to receive both analog and digital channels, for at least the reason that such features are incorporated with independent claim features that provide a complexity not anticipated or suggested by the cited art of record.

Accordingly, Applicants traverse the assertions with regard to well-known use. Because of this traversal, the Office must support its findings with evidence, or withdraw the well-known determination.

#### **IV. Inherency**

On page 5 of the Office Action, inherency is alleged with regard to claim 1, as reproduced below:



...a memory with logic (software inherently in memory to control the local server, 28; column 6, lines 1-50)...

...a processor configured with the logic (inherently present to control the local server, 28; column 6, lines 1-50) to use local data stored in the local file system. . .

Applicants respectfully disagree. The Office Action alleges that a processor configured with logic must inherently control the local server. Applicants respectfully submit that the claimed logic is not inherently present in the local server since other means may be utilized to control the processor. The Advisory Action (page 2) fails to be persuasive as to how a processor must inherently control the local server.

According to well-established Federal case law, "[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation." *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006). Thus, Applicants respectfully traverse the allegation of inherency with respect to the above-emphasized claim features in the rejection of claim 1 and respectfully request that the rejection be withdrawn for these reasons in addition to reasons presented above in Section II of the response.

## **V. Canceled Claims**

As identified above, claims 21-22, 31, 64-65, and 104-108 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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